

RECEIVED

JUN 23 2003

TECH CENTER 1600/2900
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Richard A. Mueller, et al.

Atty. Docket
No.:

10-1765.00054
(C-3128/1)

Confirmation No. 8631

Application No.: 09/625,384

Group Art Unit:

1625

Filed: July 26, 2000

Examiner:

B.M. Robinson

For: RETROVIRAL PROTEASE INHIBITORS

COMMUNICATION

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is an Applicant Initiated Interview Request Form PTOL-413A. No fee is believed to be associated with the filing of this Interview Request. However, should the United States Patent and Trademark Office determine that a fee is required the Commissioner is authorized to debit our Deposit Account No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: June 17, 2003

By: William J. Fisher

William J. Fisher
Registration No. 32,133

Banner & Witcoff, Ltd.
1001 G Street, N.W.
Washington, D.C. 20001-4597
(202) 824-3000

WJF/bao

Applicant Initiated Interview Request Form

Application No.: 09/ 625,384 First Named Applicant: Richard A. Mueller
Examiner: B. Robinson Art Unit: 1625 Status of Application: Finally Rejected

Tentative Participants:

(1) Binta M. Robinson (2) Alan L. Rotman
(3) William J. Fisher (4) Benjamin C. Spehlmann

June 26, 27
Proposed Date of Interview: July 7, 8, 9 Proposed Time: AM (AM/PM)
At Examiner's Convenience

Type of Interview Requested:

(1) ☐ Telephonic (2) ☒ Personal (3) ☐ Video Conference

Exhibit To Be Shown or Demonstrated: ☐ YES ☒ NO

If yes, provide brief description: _____

RECEIVED
TECH CENTER 1600/2900
03 JUN 17 AM 3:58

Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Restriction Requirement</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>1121 1 Utility Rejection</u>			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>1121 2 Indefinite Rejection</u> 34, 37			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) <u>1121 1 Enablement Rejection</u> R ³ , R ⁴ , R ⁵			<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☒ Continuation Sheet Attached

Brief Description of Arguments to be Presented: SEE ATTACHED SHEET

An interview was conducted on the above-identified application on _____.

NOTE:

This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

(Applicant/Applicant's Representative Signature)

(Examiner/SPE Signature)

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 21 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Comments on Brief Description of Arguments to be Presented:

- (1) Election of a species for examination provided a starting point for examination of claims 19-37. Having found this species to be allowable on the merits, the Examiner now should examine claims 19-37. These claims embrace single inventive concept. The claimed compositions have a common function - each functions as a retroviral protease inhibitor. There are no "independent and distinct" inventions requiring restriction. The claims meet the standards for further examination without additional restriction.
- (2) The Office Action is confusing. Although the rejection was withdrawn, it is repeated in the "Old rejections" section.
- (3) Claim 34: "a retroviral infection" is not indefinite. Skilled practitioners recognize that retroviral protease inhibition provides effective treatment of many diseases, which diseases are disclosed in the application by reference.

Claim 37: "in combination with other drugs" is not the entirety of the phrase. The phrase is "in combination with other drugs for the treatment of AIDS or the symptoms of AIDS." The entire phrase is not indefinite; such drugs for the treatment of AIDS or the symptoms of AIDS are described and exemplified at page 167, line 10 to page 168, line 10.

- (4) The specification clearly sets forth methods of making and using claimed invention. Considering the *Wands* factors as a whole, no undue experimentation is necessary to make and use the claimed invention.